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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/529,318

03/25/2005

Xavier Blin

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EXAMINER

GEORGE, KONATA M

ART UNIT

PAPER NUMBER

1616

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/529,318	<b>Applicant(s)</b> BLIN ET AL.	
	<b>Examiner</b> KONATA M. GEORGE	<b>Art Unit</b> 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 95-216 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 95-216 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/19/06;1/17/08</u> .   | 6) <input type="checkbox"/> Other: ____.                          |

### **DETAILED ACTION**

Claims 95-216 are pending in this application.

#### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on July 19, 2008 and January 17, 2008 was noted and the submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner has considered the information disclosure statement.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 95-99, 101-130 and 132-215 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.** Applicants use the phrase "less than or equal to" or "greater than or equal to" in the claims when describing several of the limitations of the components of the composition. It is unclear to the examiner if it is "less than", "greater than" or "equal to" are the intended values.

**Claim 134 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

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A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 134 recites the broad recitation "a Tg of less than or equal to 20°C", and the claim also recites "ranges from -50 to 0°C" which is the narrower statement of the range/limitation.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

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F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claims 95, 100-102, 104, 105, 109-111, 123, 124, 126, 128, 129, 136, 139, 141-144, 146-151 and 206-210 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 78-80, 84, 85, 87-102, 105-111, 129, 130, 132-134, 136-145, 160 and 162-164 of copending Application No. 10/528,699.** Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant invention and the copending application are directed to cosmetic compositions comprising a cosmetically acceptable liquid medium and at least one block polymer. The difference between the two is that the copending application only requires the two components, whereas, the instant invention requires three. Since both the instant invention and the copending application recite in the claim the phrase "comprising", the composition is not limited to only what is recited in the claim. Therefore, it would have been obvious to one of ordinary skill in the art to add an additional component, such as, a plasticizer to the composition of the instant invention for the purposes of adding structure to the cosmetic.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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**Claims 95, 100-102, 104, 111, 120, 123, 124, 126, 128, 129, 131-140, 146-151, 199, 201, 204-210, 212 and 213 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 85, 86, 89, 91, 92, 94-100, 108-141, 144-152, 168, 170-172, 176-182 and 184 of copending Application No. 10/528,835.** Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant invention and the copending application are directed to cosmetic compositions comprising a cosmetically acceptable liquid medium and at least one block polymer. The difference between the two lies in the third component. In the instant invention the third component is at least one plasticizer and in the copending application the third component is a gelling agent. Since both the instant invention and the copending application recite in the claim the phrase "comprising", the composition is not limited to only what is recited in the claim. Therefore, it would have been obvious to one of ordinary skill in the art to add an additional component, such as, a gelling agent to the composition of the instant invention for the purposes of forming the cosmetic into a known type of cosmetic formulation, such as, a gel.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

**Claims 95, 102, 104, 105, 109, 110, 122-124, 128, 129, 134-139, 141-144, 146-151, 199 and 201-214 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 80, 81, 84,**

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**85, 88-92, 94-99, 110, 111, 130-133, 135-137, 139-149, 160, 161 and 163-176 of copending Application No. 10/529,218.** Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant invention and the copending application are directed to cosmetic compositions comprising a cosmetically acceptable liquid medium and at least one block polymer. The difference between the two is that the copending application only requires the two components, whereas, the instant invention requires three. Since both the instant invention and the copending application recite in the claim the phrase "comprising", the composition is not limited to only what is recited in the claim. Therefore, it would have been obvious to one of ordinary skill in the art to add an additional component, such as, a plasticizer to the composition of the instant invention for the purposes of adding structure to the cosmetic.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

**Claims 95, 100, 104, 105, 112, 113, 122-124, 126, 128, 129, 136-140, 144, 146-151, 196, 199-210, 212 and 213 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 78108-110, 114, 117-123, 125, 145, 146, 159-164, 168-176, 200-203, 207-209, 211 and 213-219 of copending Application No. 10/528,265.** Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant invention and the copending application are directed to cosmetic compositions comprising a cosmetically acceptable liquid medium and at least one block polymer.

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The difference between the two is that the copending application only requires the two components, whereas, the instant invention requires three. Since both the instant invention and the copending application recite in the claim the phrase "comprising", the composition is not limited to only what is recited in the claim. Therefore, it would have been obvious to one of ordinary skill in the art to add an additional component, such as, a plasticizer to the composition of the instant invention for the purposes of adding structure to the cosmetic.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

**Claims 95, 101, 102, 104-108, 120, 123, 124, 129, 131, 133, 135-139, 146-151, 199 and 202-214 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 77, 78, 82, 85, 95-103, 108-154, 158-163, 165-169 and 171-174 of copending Application No. 10/529,266.** Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant invention and the copending application are directed to cosmetic compositions comprising a cosmetically acceptable liquid medium and at least one block polymer. The difference between the two is that the copending application only requires the two components, whereas, the instant invention requires three. Since both the instant invention and the copending application recite in the claim the phrase "comprising", the composition is not limited to only what is recited in the claim. Therefore, it would have been obvious to one of ordinary skill in the



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art to add an additional component, such as, a plasticizer to the composition of the instant invention for the purposes of adding structure to the cosmetic.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

**Claims 95, 100-105, 123, 124, 128, 131, 136-139, 141, 142, 147-151, 188-197, 200, 206-108, 210 and 211 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 87-99, 133,-138, 140, 143-148, 152-158, 164-166, 172, 173, 181-183 and 185-187 of copending Application No. 10/529,267.** Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant invention and the copending application are direct to cosmetic compositions comprising a cosmetically acceptable liquid medium and at least one block polymer. The difference between the two is that the copending application only requires the two components, whereas, the instant invention requires three. Since both the instant invention and the copending application recite in the claim the phrase "comprising", the composition is not limited to only what is recited in the claim. Therefore, it would have been obvious to one of ordinary skill in the art to add an additional component, such as, a plasticizer to the composition of the instant invention for the purposes of adding structure to the cosmetic.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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**Claims 95, 100, 101, 105, 120, 123, 124, 126, 136-138, 146-151 and 206-210 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10, 41-43, 50-55 and 86-90 of copending Application No. 10/585,817.** Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant invention and the copending application are directed to cosmetic compositions comprising a cosmetically acceptable liquid medium and at least one block polymer. The difference between the two is that the copending application only requires the two components, whereas, the instant invention requires three. Since both the instant invention and the copending application recite in the claim the phrase "comprising", the composition is not limited to only what is recited in the claim. Therefore, it would have been obvious to one of ordinary skill in the art to add an additional component, such as, a plasticizer to the composition of the instant invention for the purposes of adding structure to the cosmetic.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

**Claims 95, 100, 101, 105, 120, 123, 124, 126, 136-138, 146-151, 196, 200 and 206-210 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13, 42-45, 69, 75, 76 and 82-86 of copending Application No. 10/585,818.** Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant invention and the copending application are directed to cosmetic compositions

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comprising a cosmetically acceptable liquid medium and at least one block polymer.

The difference between the two lies in the third component. In the instant invention the third component is at least one plasticizer and in the copending application the third component is a gelling agent. Since both the instant invention and the copending application recite in the claim the phrase "comprising", the composition is not limited to only what is recited in the claim. Therefore, it would have been obvious to one of ordinary skill in the art to add an additional component, such as, a plasticizer to the composition of the instant invention for the purposes of adding structure to the cosmetic.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

**Claims 95, 100-102, 104, 105, 109-111, 123, 124, 126, 128, 129, 136, 139, 141-144, 146-151 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 6, 10-19, 22-27, 41-44, 69-71 and 88-96 of copending Application No. 10/949,448.**

Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant invention and the copending application are directed to cosmetic compositions comprising a cosmetically acceptable liquid medium and at least one block polymer. The difference between the two is that the copending application only requires the two components, whereas, the instant invention requires three. Since both the instant invention and the copending application recite in the claim the phrase "comprising", the composition is not limited to only what is recited in the

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claim. Therefore, it would have been obvious to one of ordinary skill in the art to add an additional component, such as, a plasticizer to the composition of the instant invention for the purposes of adding structure to the cosmetic.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 95-100, 102, 104, 105, 109, 126, 131, 132, 135, 136, 139, 140, 143-151, 153, 154-158, 161, 175, 178-181, 184, 185, 199-201 and 214 are rejected under 35 U.S.C. 102(b) as being anticipated by Bednarek et al. (US 6,254,878).

Bednarek et al. disclose a nail polish comprising a solvent system and a binder comprising acrylic copolymers (col. 1, lines 46-63) and further comprising a plasticizer (col. 8, lines 51-65). Column 3, lines 18-34 disclose suitable non-aqueous solvents which are organic for use in the solvent system. Column 6, lines 52-54 teach that the binders can be random, block, branched or grafted polymers. Column 8, lines 31-30 gives examples of preferred binders, for example, butyl acrylate (Tg -54°C, 5 wt. %), butyl methacrylate (Tg 20°C, 65 wt. %), maleic anhydride (20 wt. %) and acrylic acid (10 wt. %). Column 8, lines 40-44 disclose the molecular weight of the binder as between

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10,000-3,000,000, preferably 10,000 to 200,000. Column 17, line 16 discloses that the nail polish can comprise 5-80% of the binder. Column 8, lines 51-65 disclose examples of the plasticizer, such as, tributyl acetyl citrate, tri-2-ethylhexyl acetyl citrate, etc.

Column 9, lines 2-5 teach that the amount of plasticizer used in the polish ranges from about 3 to 10%. Column 8, lines 46-50 teach that the composition may also contain other ingredients commonly used in nail polishes, such as, film-former, fragrances, etc.

Column 2, lines 56-62 disclose that two types of nail polishes can be made, a clear coat nail polish and a colored nail polish comprising a pigment in the composition. Bednarek et al. do not explicitly teach the hardness of the film, solubility parameter or the polydispersity index. It is the position of the examiner that the hardness of the film and the solubility parameter are functional limitations of the plasticizer. Since the plasticizers as disclosed in Bednarek et al. are the same as those claimed in the instant invention, the plasticizers of Bednarek et al. will also have the same limitations and would be inherent. The same argument is raised with respect to the limitations of the polydispersity index of the block polymer.

### ***Conclusion***

Claims 95-216 are rejected.

***Telephone Inquiries***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Konata M. George, whose telephone number is 571-272-0613. The examiner can normally be reached from 8:00AM to 6:30PM Monday to Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter, can be reached at 571-272-0646. The fax phone numbers for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have question on access to the Private Pair system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Konata M. George/  
Primary Examiner, Art Unit 1616